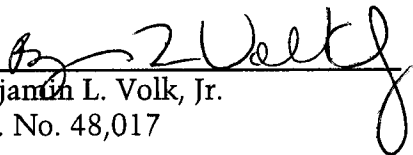


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF E-FILING

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Reg. No. 48,017

In re application of:
Weinstock et al.

Serial No.: 09/694,050

Filed: October 20, 2000

For: Extended Web Enabled Business To
Business Computer System For Rental
Vehicle Services

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Examiner: Morgan, Robert

Group Art Unit: 3626

Reply Brief

In response to the Examiner's Answer dated August 12, 2008, Appellant submits the following as its Reply Brief in connection with the appeal of the above-referenced patent application.

I. The Examiner's Answer Fails to Address the Evidence of Record

As an initial matter, Appellant submits that the Examiner's Answer fails to address in any way the content of the "Declaration B of David Smith", the "Declaration of Russell Dittmar", and U.S. Patent Application Publication 2002/00091533 that are of record in this patent application. As such, Appellant respectfully submits that this evidence stands unrefuted by the Examiner and mandates a reversal of the Examiner's rejections. While the Examiner discounted these declarations without substantive consideration of their content on the ground of "opinion" and "self-serving" bias at page 19 in the Office Action dated August 15, 2006,

Appellant respectfully submits that such a reason for nonconsideration by the Examiner constitutes reversible error, as set forth in the Amended Appeal Brief at pages 15-18. (See In re Sullivan, 84 USPQ2d 1034, 1038 (Fed. Cir. 2007); In re Oelrich and Divigard, 198 USPQ 210, 213-15 (CCPA 1978); In re Lemin, 150 USPQ 546, 547-49 (CCPA 1966); In re Lindell, 155 USPQ 521, 524 (CCPA 1967)). Now, having once again failed to address the substantive content of these two declarations, Appellant respectfully submits that the Examiner's Answer has failed to ameliorate the reversible error committed in the August 15, 2006 Office Action.

**II. The Examiner's Answer Fails to Establish a Valid Motivation
for Combining the Cited Prior Art References**

The Examiner's Answer clarifies that the rationale relied upon by the Examiner to reject the claims for obviousness is the "teaching, suggestion, motivation" (TSM) rationale for obviousness. (See Examiner's Answer; p. 15-16). More specifically, the Examiner's Answer asserts that a person having ordinary skill in the art would have found it obvious to (1) combine Walker's CPO-based reservation system with the 1995 ARMS system (as exemplified by the "Many Ways to Sell" article) "with the motivation of allowing authorized user[s] to provide reliable and dependable service to customer[s] involved in rental insurance claim[s]" (referred to hereinafter as "Alleged Motivation 1"), and (2) combine Brandt's FlowMark software with Walker's CPO-based system and the 1995 ARMS system "with the motivation of providing a faster and more efficient way to process car rental application[s] without any human intervention" (referred to hereinafter as "Alleged Motivation 2"). (See Examiner's Answer; p. 5-6). However, the Office Action of April 5, 2007 and the Examiner's Answer fail to provide any evidence that such a motivation exists.

Instead, as explained in Appellant's Amended Appeal Brief, the unrefuted evidence of record in this patent application establishes that no such motivations to combine the cited prior art references existed. The unrefuted evidence of record in this patent application demonstrates that not only are Alleged Motivation 1 and Alleged Motivation 2 non-existent, but in fact the cited references themselves expressly taught a motivation to not combine the references in the manner asserted by the Examiner. In short, and as explained in greater detail in the Amended Appeal Brief, the **unrefuted evidence of record** demonstrates that no teaching,

suggestion, or motivation existed in the prior art to combine the cited prior art in the manner asserted by the Examiner because:

- The use of Walker's CPO-based buyer-driven market system in combination with the 1995 ARMS system and Brandt's software would (1) render the users of the 1995 ARMS system uncertain as to whether they have successfully booked a rental vehicle reservation for their drivers, (2) destroy the efficiency of the 1995 ARMS system because of the human intervention that would be need to sift through CPOs and identify CPS suitable for acceptance (as well as human review of possible CPO counteroffers from the rental vehicle service providers), and (3) cause the users of such a combined system to lose the "mastery of their offers" because the rental vehicle service providers will select the users with which they want to do business rather than the users selecting the rental vehicle service providers with which they want to do business. (See, e.g., Exhibit A of the Amended Appeal Brief ("Declaration B of D. Smith")). As such, this evidence serves as an unrefuted rebuttal of Alleged Motivations 1 and 2 because this evidence establishes how the Examiner's asserted combination would (1) hinder rather than provide for increased reliability and dependability and (2) reduce speed and efficiency rather than enhance speed and efficiency.
- Brandt's FlowMark software is ill-suited for use in a business-to-multibusiness application, as recognized by IBM, the provider of the FlowMark software. (See, e.g., Exhibit C of the Amended Appeal Brief (U.S. Patent Application Publication 2002/0091533); paragraphs 16-17); Exhibit B of the Amended Appeal Brief ("Declaration of R. Dittmar"); paragraph 10). As such, this evidence serves as an unrefuted and corroborated rebuttal of Alleged Motivation 2 because it establishes that even the assignee of the FlowMark software believed the FlowMark software to be ill-suited for use with a system such as the claimed invention.

Therefore, Appellant respectfully submits that the unrefuted evidence of record in this patent application demonstrates that no teaching, suggestion, motivation or other reason existed to combine the cited prior art references in the manner asserted by the Examiner.

Moreover, the Examiner's Answer evidences a fundamental defect in addressing Appellant's reasoning and evidence in favor of patentability when the Examiner's Answer states that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference". (See Examiner's Answer; p. 13-14). Appellant interprets this statement as a mis-directed rebuttal to the issue raised by Appellant in footnote 3 on page 14 of the Amended Appeal Brief. However, Appellant respectfully submits that the Examiner's statement is not applicable to the patentability issues in this appeal. The Examiner's obviousness rejection of the claimed invention is predicated on a finding by the Examiner that a person having ordinary skill in the art would have been motivated to incorporate Brandt's automatic car rental process model with Walker's CPO-based reservation system and the 1995 ARMS system to arrive at the claimed invention. (See Examiner's Answer; p. 15, see also p. 6). However, as explained at pages 11-12 in the Amended Appeal Brief, Walker requires that its CPOs be reviewed manually by sellers before acceptance, and the Examiner fails to explain how Brandt's system would be understood by a person having ordinary skill in the art to automatically accept Walker's CPOs.

Given that Walker teaches that CPOs require human intervention so that the terms of the CPO can be evaluated before a CPO is accepted to create a reservation, the Examiner has failed to explain how Brandt teaches a person having ordinary skill in the art to overcome this constraint of the Walker system. Furthermore, to the extent that the Examiner's Answer at pages 13-14 assumes that a person having ordinary skill in the art, when combining Walker with Brandt, would eliminate Brandt's CPO from the combined system, Appellant asserts that the need for such a modification to the systems disclosed by the prior art references establishes the nonobviousness of the claimed invention. That is, if a proposed modification to a prior art reference would render that prior art invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (see also MPEP §2143.01(V)). Furthermore, Appellant submits that no motivation exists to combine Walker with Brandt and the 1995 ARMS system to arrive at the claimed invention if such a combination would eliminate Walker's CPOs because to do so would completely change Walker's principle of operation (which revolves around CPOs). (See In re Ratti, 123 USPQ 349, 352 (CCPA 1959) (no motivation or

suggestion to combine prior art references is found where the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [Prior Art Reference A] as well as a change in the basic principles under which the [Prior Art Reference A] was designed to operate.”) (see also MPEP §2143.01(VI))).

Thus, Appellant does not assert that Brandt cannot be bodily incorporated into Walker. Instead, Appellant respectfully asserts that no motivation exists to combine Walker, Brandt, and the 1995 ARMS system in the manner asserted by the Examiner because to do so would require a person having ordinary skill in the art to completely change Walker’s principle of operation and render Walker’s CPO-based system unsatisfactory for its intended purpose.

For this reason, Appellant asserts that even if a motivation to combine Walker, the 1995 ARMS system and Brandt existed, the resultant combination would still employ Walker’s CPO-based reverse auction system. Because the CPO-based reverse auction system requires human intervention before a buyer’s reservation request can be accepted, such a prior art combination would fail to meet all elements of claims 96 and 113 because the resultant prior art combination system would not satisfy: (1) the elements of claim 96 which recite “wherein the rental vehicle software program is configured to ... automatically book, in response to input from the user, a rental vehicle reservation with the competitive rental vehicle service provider that operates the computer network without human intervention on the part of personnel of the competitive rental vehicle service provider that operates the computer network” or (2) the elements of claim 113 which recite “executing the rental vehicle software program in response to the series of commands to thereby ... automatically book a rental vehicle reservation with the competitive rental vehicle service provider that maintains the computer network without human intervention on the part of personnel of the competitive rental vehicle service provider that maintains the computer network”.

The distinction between a CPO-based reverse auction system such as that disclosed by Walker and the buyer-controlled system of the claimed invention is a basic distinction permeating each system that militates against any motivation to employ Walker’s CPO-based system in a system such as the present invention. The reverse auction CPO system’s very reason for being is to create competition by sellers for the buyer’s business, including active bidding for the buyer’s business, which if not eventually satisfactory to the buyer could end up

with no transaction taking place, all at the whim of the buyer. Instead, in the system of claim 96, "at least one of the GUI menus is configured to accept a selection by the user as to which one of the plurality of competitive rental vehicle service providers that a rental vehicle reservation is to be booked with", and "wherein the rental vehicle software program is configured to (1) automatically book, in response to input from the user, a rental vehicle reservation with the competitive rental vehicle service provider that operates the computer network without human intervention on the part of personnel of the competitive rental vehicle service provider that operates the computer network", and in the method of claim 113, "in response to a selection by the user of a competitive rental vehicle service provider that maintains the computer network, ... executing the rental vehicle software program in response to the series of commands to thereby ... automatically book a rental vehicle reservation with the competitive rental vehicle service provider that maintains the computer network without human intervention on the part of personnel of the competitive rental vehicle service provider that maintains the computer network". Thus, the buyer irretrievably places his/her business with a selected seller on certain terms that do not include any bidding or competition during this activity on the part of the sellers. With respect to reliability and efficiency, this distinction is like comparing a buyer bidding on eBay with a buyer placing an affirmative order. The eBay bidder does not know if he/she has bought anything until the bidding closes and the seller agrees. With Walker's system, the buyer does not know if he/she has successfully booked a reservation for a driver until the different sellers review the bid and decide whether to accept the bid, with the first to accept winning the business. On eBay, the bidding can take hours or days, and the buyer will not know until after that time whether a successful transaction has been made. Thus, such transaction modes detract from reliability, dependability, speed and efficiency. With the claimed invention, even small delays in handling reservation transactions hinder the effective operation of the system, and such shortcomings described above as inherent in the Walker system make Walker and the present invention incompatible and not likely to be considered as a proper reference for combination by one of ordinary skill in the art.

III. The Examiner's Answer Fails to Establish How the Cited Prior Art Combination Results in the "Selection" Element of the Claims Being Met

The Examiner's Answer admits that both Walker and the Walker/1995 ARMS system combination fail to yield (1) the element in claim 96 "wherein at least one of the GUI menus is configured to accept a selection by the user as to which one of the plurality of competitive rental vehicle service providers that a rental vehicle reservation is to be booked with" and (2) the element in claim 113 of "providing a user of the authorized purchaser computer with an option through the Internet web portal to select a rental vehicle service provider with which to book a rental vehicle reservation from among a plurality of competitive rental vehicle service providers". (See Examiner's Answer; p. 4, 5, and 10). Furthermore, the Examiner's Answer fails to explain where or how Brandt provides a teaching that would render it obvious to incorporate these elements from claims 96 and 113 into the Walker and 1995 ARMS systems. (See Examiner's Answer; p. 6 (which omits any discussion of how Brandt teaches, discloses, or suggests such a feature)). This failure in the Examiner's Answer establishes yet another reason for reversing the Examiner's claim rejections and allowing the claims because even if Walker, the 1995 ARMS system, and Brandt were combined as asserted by the Examiner, the resultant combination would still fail to yield all elements of the claims.

IV. Conclusion

Therefore, Appellant respectfully submits that (1) the Examiner's rejection of the claims must be reversed and (2) the claims are patentable over the cited references because:

- The Examiner has failed to even acknowledge, much less substantively consider, the evidence that Appellant has submitted in favor of patentability. Having failed to acknowledge, much less overcome, the weight of this evidence, the Examiner has left it unrefuted in the record which commands a reversal of the rejections.
- The unrefuted evidence of record not only effectively rebuts the Examiner's alleged motivations to combine but also establishes that a person having ordinary skill in the art would have been motivated not to combine the cited prior art references in the manner suggested by the Examiner.

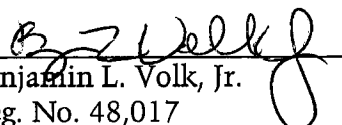
- Even assuming for the sake of argument that one of ordinary skill in the art would seek to combine the cited prior art references, the resultant combination would not only be ill-suited for the task but still fail to yield all elements of independent claims 96 and 113. In particular, the resultant combination would fail to meet (1) the elements from claims 96 and 113 which require that rental vehicle reservations be booked "automatically" and "without human intervention on the part of personnel of the competitive rental vehicle service provider", and (2) the elements from claims 96 and 113 which recite "at least one of the GUI menus is configured to accept a selection by the user as to which one of the plurality of competitive rental vehicle service providers that a rental vehicle reservation is to be booked with" (claim 96) and "providing a user of the authorized purchaser computer with an option through the Internet web portal to select a rental vehicle service provider with which to book a rental vehicle reservation from among a plurality of competitive rental vehicle service providers" (claim 113).

Thus, for the reasons expressed herein and in Appellant's Amended Appeal Brief, Appellant respectfully submits that the Examiner's rejections as to all pending claims in this patent application are in error and must be reversed. Favorable consideration of this appeal and a speedy allowance is respectfully requested.

Respectfully submitted,

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